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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,790	12/15/2005	Peter Ghosh	10682.0010USWO	4918
23552 7590 04/04/2008 MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903				
EXAMINER				
ROOKE, AGNES BEATA				
ART UNIT		PAPER NUMBER		
1656				
MAIL DATE		DELIVERY MODE		
04/04/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/560,790

**Applicant(s)**

GHOSH, PETER

**Examiner**

AGNES B. ROOKE

**Art Unit**

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-64 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. Claims 29-33, drawn to a composition of SEQ ID NO:1, classified in class 530, subclass 350.
2. Claims 29-33, drawn to a composition of SEQ ID NO:14, classified in class 530, subclass 350.
3. Claims 29-32, drawn to a composition of SEQ ID NO:16, classified in class 530, subclass 350.
4. Claims 29-32, drawn to a composition of SEQ ID NO:18, classified in class 530, subclass 350.
5. Claims 29 and 34, drawn to a composition of SEQ ID NO:2, classified in class 530, subclass 350.
6. Claims 29 and 34, drawn to a composition of SEQ ID NO:3, classified in class 530, subclass 350.
7. Claims 29 and 34, drawn to a composition of SEQ ID NO:4, classified in class 530, subclass 350.
8. Claims 29 and 34, drawn to a composition of SEQ ID NO:5, classified in class 530, subclass 350.
9. Claims 29 and 34, drawn to a composition of SEQ ID NO:6, classified in class 530, subclass 350.

10. Claims 29 and 34, drawn to a composition of SEQ ID NO:7, classified in class 530, subclass 350.
11. Claims 29 and 34, drawn to a composition of SEQ ID NO:8, classified in class 530, subclass 350.
12. Claims 29 and 34, drawn to a composition of SEQ ID NO:9, classified in class 530, subclass 350.
13. Claims 29 and 34, drawn to a composition of SEQ ID NO:10, classified in class 530, subclass 350.
14. Claims 29 and 34, drawn to a composition of SEQ ID NO:11, classified in class 530, subclass 350.
15. Claims 35-39, drawn to a method of inducing tolerance using SEQ ID NO:1, classified in class 514, subclass 12.
16. Claims 35-39, 41, drawn to a method of inducing tolerance using SEQ ID NO:14, classified in class 514, subclass 12.
17. Claims 35-38, 41, drawn to a method of inducing tolerance using SEQ ID NO:16, classified in class 514, subclass 12.
18. Claims 35-38, 41, drawn to a method of inducing tolerance using SEQ ID NO:18, classified in class 514, subclass 12.
19. Claims 35 and 40, 41, drawn to a method of inducing tolerance using SEQ ID NO:2, classified in class 514, subclass 12.
20. Claims 35 and 40, 41, drawn to a method of inducing tolerance using SEQ ID NO:3, classified in class 514, subclass 12.

21. Claims 35 and 40, 41, drawn to a method of inducing tolerance using SEQ ID NO:4, classified in class 514, subclass 12.
22. Claims 35 and 40, 41, drawn to a method of inducing tolerance using SEQ ID NO:5, classified in class 514, subclass 12.
23. Claims 35 and 40, 41, drawn to a method of inducing tolerance using SEQ ID NO:6, classified in class 514, subclass 12.
24. Claims 35 and 40, 41, drawn to a method of inducing tolerance using SEQ ID NO:7, classified in class 514, subclass 12.
25. Claims 35 and 40, 41, drawn to a method of inducing tolerance using SEQ ID NO:8, classified in class 514, subclass 12.
26. Claims 35 and 40, 41, drawn to a method of inducing tolerance using SEQ ID NO:9, classified in class 514, subclass 12.
27. Claims 35 and 40, 41, drawn to a method of inducing tolerance using SEQ ID NO:10, classified in class 514, subclass 12.
28. Claims 35 and 40, 41, drawn to a method of inducing tolerance using SEQ ID NO:11, classified in class 514, subclass 12.
29. Claims 42-48, 50, drawn to a method of preventing degenerative condition by using SEQ ID NO:1, classified in class 530, subclass 350.
30. Claims 42-48, 50, drawn to a method of preventing degenerative condition by using SEQ ID NO:14, classified in class 530, subclass 350.
31. Claims 42-47, 50, drawn to a method of preventing degenerative condition by using SEQ ID NO:16, classified in class 514, subclass 12.

- 32. Claims 42-47, 50, drawn to a method of preventing degenerative condition by using SEQ ID NO:18, classified in class 514, subclass 12.
- 33. Claims 42, 49, 50, drawn to a method of preventing degenerative condition by using SEQ ID NO:2, classified in class 514, subclass 12.
- 34. Claims 42, 49, 50, drawn to a method of preventing degenerative condition by using SEQ ID NO:3, classified in class 514, subclass 12.
- 35. Claims 42, 49, 50, drawn to a method of preventing degenerative condition by using SEQ ID NO:4, classified in class 514, subclass 12.
- 37. Claims 42, 49, 50, drawn to a method of preventing degenerative condition by using SEQ ID NO:5, classified in class 514, subclass 12.
- 36. Claims 42, 49, 50, drawn to a method of preventing degenerative condition by using SEQ ID NO:6, classified in class 514, subclass 12.
- 37. Claims 42, 49, 50, drawn to a method of preventing degenerative condition by using SEQ ID NO:7, classified in class 514, subclass 12.
- 38. Claims 42, 49, 50, drawn to a method of preventing degenerative condition by using SEQ ID NO:8, classified in class 514, subclass 12.
- 39. Claims 42, 49, 50, drawn to a method of preventing degenerative condition by using SEQ ID NO:9, classified in class 514, subclass 12.
- 40. Claims 42, 49, 50, drawn to a method of preventing degenerative condition by using SEQ ID NO:10, classified in class 514, subclass 12.
- 41. Claims 42, 49, 50, drawn to a method of preventing degenerative condition by using SEQ ID NO:11, classified in class 514, subclass 12.

42. Claims 51-52, drawn to a method for isolating a peptide, classified in class 530, subclass 350.
43. Claims 53-57, drawn to a method for preventing an autoimmune response by using SEQ ID NO:1, classified in class 514, subclass 12.
44. Claims 53-57, drawn to a method for preventing an autoimmune response by using SEQ ID NO:14, classified in class 514, subclass 12.
45. Claims 53-56, drawn to a method for preventing an autoimmune response by using SEQ ID NO:16, classified in class 514, subclass 12.
46. Claims 53-56, drawn to a method for preventing an autoimmune response by using SEQ ID NO:18, classified in class 514, subclass 12.
47. Claims 53 and 58, drawn to a method for preventing an autoimmune response by using SEQ ID NO:2, classified in class 514, subclass 12.
48. Claims 53 and 58, drawn to a method for preventing an autoimmune response by using SEQ ID NO:3, classified in class 514, subclass 12.
49. Claims 53 and 58, drawn to a method for preventing an autoimmune response by using SEQ ID NO:3, classified in class 514, subclass 12.
50. Claims 53 and 58, drawn to a method for preventing an autoimmune response by using SEQ ID NO:4, classified in class 514, subclass 12.
51. Claims 53 and 58, drawn to a method for preventing an autoimmune response by using SEQ ID NO:5, classified in class 514, subclass 12.
52. Claims 53 and 58, drawn to a method for preventing an autoimmune response by using SEQ ID NO:6, classified in class 514, subclass 12.

53. Claims 53 and 58, drawn to a method for preventing an autoimmune response by using SEQ ID NO:7, classified in class 514, subclass 12.
54. Claims 53 and 58, drawn to a method for preventing an autoimmune response by using SEQ ID NO:8, classified in class 514, subclass 12.
55. Claims 53 and 58, drawn to a method for preventing an autoimmune response by using SEQ ID NO:9, classified in class 514, subclass 12.
56. Claims 53 and 58, drawn to a method for preventing an autoimmune response by using SEQ ID NO:10, classified in class 514, subclass 12.
57. Claims 53 and 58, drawn to a method for preventing an autoimmune response by using SEQ ID NO:11, classified in class 514, subclass 12.
58. Claims 59-63, drawn a method of inducing cartilage formation by using SEQ ID NO:1, classified in class 514, subclass 12.
59. Claims 59-63, drawn a method of inducing cartilage formation by using SEQ ID NO:14, classified in class 514, subclass 12.
60. Claims 59-62, drawn to a method of inducing cartilage formation by using SEQ ID NO:16, classified in class 514, subclass 12.
61. Claims 59-62, drawn to a method of inducing cartilage formation by using SEQ ID NO:18, classified in class 514, subclass 12.
62. Claims 59 and 64, drawn to a method of inducing cartilage formation by using SEQ ID NO:2, classified in class 514, subclass 12.
63. Claims 59 and 64, drawn to a method of inducing cartilage formation by using SEQ ID NO:3, classified in class 514, subclass 12.



64. Claims 59 and 64, drawn to a method of inducing cartilage formation by using SEQ ID NO:4, classified in class 514, subclass 12.
65. Claims 59 and 64, drawn to a method of inducing cartilage formation by using SEQ ID NO:5, classified in class 514, subclass 12.
66. Claims 59 and 64, drawn to a method of inducing cartilage formation by using SEQ ID NO:6, classified in class 514, subclass 12.
67. Claims 59 and 64, drawn to a method of inducing cartilage formation by using SEQ ID NO:7, classified in class 514, subclass 12.
68. Claims 59 and 64, drawn to a method of inducing cartilage formation by using SEQ ID NO:8, classified in class 514, subclass 12.
69. Claims 59 and 64, drawn to a method of inducing cartilage formation by using SEQ ID NO:9, classified in class 514, subclass 12.
70. Claims 59 and 64, drawn to a method of inducing cartilage formation by using SEQ ID NO:10, classified in class 514, subclass 12.
71. Claims 59 and 64, drawn to a method of inducing cartilage formation by using SEQ ID NO:11, classified in class 514, subclass 12.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups 1-14 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the polypeptides of Groups 1-14 are distinct because they have different structure and thus have different function. Therefore, the inventions are distinct.

Inventions of Groups 1-14 and inventions of Groups 15-28 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the methods of Groups 15-28 can be practiced with different products as disclosed in inventions of Groups 1-14, since different polypeptides can be used in the same method. Therefore, the inventions are distinct.

Inventions of Groups 1-14 and inventions of Groups 29-41 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the methods of Groups 29-41 can be practiced with different products as disclosed in inventions of Groups 1-14, since different polypeptides can be used in the same method. Therefore, the inventions are distinct.

Inventions of Groups 1-14 and invention of Group 42 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the invention

of Group 42 can produce different products as disclosed in inventions of Groups 1-14. Therefore, the inventions are distinct.

Inventions of Groups 1-14 and inventions of Groups 43-57 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the methods of Groups 43-57 can be practiced with different products as disclosed in inventions of Groups 1-14, since different polypeptides can be used in the same method. Therefore, the inventions are distinct.

Inventions of Groups 1-14 and inventions of Groups 58-71 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the methods of Groups 58-71 can be practiced with different products as disclosed in inventions of Groups 1-14, since different polypeptides can be used in the same method. Therefore, the inventions are distinct.

Inventions of Groups 15-71 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

process of using that product. See MPEP § 806.05(h). In the instant case, each of the groups utilize different compositions and each of the groups have different modes of operation, for example, inventions of Groups 15-28 are directed to a method of inducing tolerance and utilize distinct polypeptides, thus the groups are distinct among each other. The inventions of Groups 29-41 are directed to a method of preventing degenerative condition and utilize distinct polypeptides, thus the groups are distinct among each other. The inventions of Groups 43-57 are directed to a method of preventing autoimmune response and utilize different polypeptides, thus the groups are distinct among each other. The inventions of Groups 58-71 are directed to a method of inducing cartilage formation and utilize distinct polypeptides, thus the groups are distinct among each other. Finally, Group 42 is directed to a method of isolating polypeptides that share a common function. Thus, all the aforementioned groups are distinct among each other because they utilize different polypeptides and have different modes of operation. Therefore, the aforementioned groups are distinct from each other.

Further, they would be an undue burden to the examiner to search all groups separately since each group involves a distinct polypeptide and there are several methods to be search.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise**

**include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Art Unit: 1656

Applicant is advised that the reply to this requirement to be complete must include an election of the Invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Agnes Rooke whose telephone number is 571-272-2055. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr Bragdon can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information about the PAIR system, see <http://pair-direct.uspto.gov>. or call 866-217-9197.

AR

/Karen Cochrane Carlson, Ph.D./

Primary Examiner, Art Unit 1656







